Docket No. CITI0015-US   PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the U.S. Application of

Paul SIDIKMAN et al.   Group Art Unit: 2164

U.S. Serial No.: 09/006,839

Examiner: Kazimi, H.

Filed: January 12, 1998

For: METHOD AND SYSTEM FOR PROVIDING INTEGRATED BROKERAGE AND
       OTHER FINANCIAL SERVICES THROUGH CUSTOMER ACTIVATED
       TERMINALS

APPEAL BRIEF

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Commissioner of Patents
Washington, D.C. 20231

Sir:

This is an Appeal Brief under 37 C.F.R. § 1.192 in connection with the decisions of

the Examiner in a Final Office Action mailed on August 12, 2002. Each of the topics

required by Rule 192 is presented herewith and is labeled appropriately.

(1)   Real Party In Interest

The real party in interest is Citibank, N.A.

(2)   Related Appeals And Interferences

There are no other appeals or interferences related to this case.

(3)   Status Of Claims

Claims 19-37 are pending and rejected. Claims 19-37 are hereby appealed.

(4)   Status of Amendments

There are no outstanding amendments.

(5)   Summary Of The Invention

The present invention is directed to a system and method for providing brokerage services, including buying and selling securities and obtaining security price quotes, through a network of automated teller machines. Page 1, lines 20-24. Accordingly, there is provided an integrated financial system and method comprising an automated teller machine for providing a customer interface to the financial system. The automated teller machine includes processor means, input means for receiving customer information from a customer, display means for displaying information to the customer, and a dispenser mechanism, wherein the processor means receives the customer information and controls the display and the dispensing mechanism. Page 7, lines 5-35.

The system and method also include first communication means for remote transmission of first data from the automated teller machine to a front end processor system. The front end system is coupled to the first communication means and interprets the data from the automated teller machine. It provides data to the automated teller machine whereby the front end processor system controls a plurality of customer interactive processes implemented through the automated teller machine processor means. The system also includes second communication means for transmission of third data from the front end processor system and a brokerage system. The brokerage system receives data from the front end processor system through the second communications means and provides fourth data thereto. The brokerage system maintains a record corresponding to a brokerage account, which includes indicia of the number and type of securities held on behalf of the customer. Further, the brokerage system receives trade orders from the customer through the automated teller machine and the front end system and places orders to implement the orders. Id.

According to the present invention, the integrated financial system and method can also include: a quotation system for providing securities price information substantially in

real time through the brokerage system, the front end processor and the automated teller machine; means to compute a current value of securities held on behalf of a customer based on the securities price information, wherein the current value is displayed to the customer with the automated teller machine upon request of the customer; and means for cross referencing a security symbol with other information, including a security name, in response to a customer request. Page 8, lines 1-22.

(6)   Issue

Whether the Examiner's rejection of claims 19-37 under 35 U.S.C. 102(a) as being anticipated by "Trade it Yourself Bank Machines Make a Debut Securities," (hereinafter, "cited newswire") is proper.

(7)   Grouping of Claims

There are 19 pending claims (claims 19-37), which are arranged into 19 groups, each group containing a separate claim (e.g., group 1 contains claim 19, group 2 contains claim 20, group 3 contains claim 21, ..., group 19 contains claim 37). Each group, and hence each claim, stands or falls separately for purposes of this appeal.

(8)   Argument

The rejection of claims 19-37 Under 35. U.S.C. 102(a) is not proper

According to MPEP 2131 regarding a prior-art rejection of *anticipation* under 35 U.S.C. 102(a), (b), and (e), "[a] claim is *anticipated* only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (Emphasis added). (Quoting Verdegaal Bros. v. Union Oil Col. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Regarding claim 19, it is respectfully submitted that the purported teaching in the cited newswire is sparse and unclear and does not disclose Applicants' invention *as claimed*, which is a requirement for any asserted prior art rejection under 35 U.S.C. 102(a), as

confirmed by MPEP 2131. For instance, the cited newswire discusses generally the use of automated teller machines (ATMs) by users to buy and sell stocks and mutual funds and check balances in brokerage accounts. There is no discussion in the cited newswire of the actual method and detailed steps set forth in at least independent claim 19 of the present invention. At most, the cited newswire describes,

> "The Citibank system pivots on specially designed automated teller machines that have separate 'menus' for banking and brokerage services. Customers who want to access their stock account will select a button that says 'brokerage services: Not FDIC insured.'" The cited newswire, third paragraph from the last.

And that,

> "The [ATM] screen offers a choice between information or trading. If you choose to trade, the next screen is a full-page of disclosure about stock market risks. Those who just want to check stock prices will pull up a picture of a typewriter keyboard. By touching the screen, they can type in the name of the company or its sticker symbol and get a real-time stock quote or the previous day's mutual fund closing price." Id., last two paragraphs.

Hence, the cited newswire does not expressly or inherently describe each and every claimed limitation as set forth in independent claim 19, such as at least those limitations highlighted in the recitation of the claim below.

> *19. (Recited) A method for a user at an automatic teller machine to obtain securities information and transactions, comprising:*
>
> *the user accessing the automatic teller machine;*
>
> *the automatic teller machine prompting the user with an option to perform securities functions;*
>
> *the user selecting the option to perform securities functions;*
>
> *automatically prompting the user to select a securities function from a securities function group of obtain information, buy securities, and sell securities;*
>
> *the user selecting a securities function from the securities function group;*
>
> ***if the user selects the securities function of obtain information, automatically prompting the user to select one information type from an information type group of holdings, stock quotes, symbol directory, and activity and orders;***
>
> *the user selecting an information type from the information type group;*
>
> *providing to the user information for the selected information types;*
>
> ***if the user selects one securities function from the securities function group of buy securities and sell securities, automatically determining whether the user has established a linked brokerage account;***

if the user has established a linked brokerage account, automatically determining whether the user has multiple brokerage accounts;

if the user does not have multiple brokerage accounts, automatically presenting the user with a portfolio profile message;

automatically determining whether a broker system is available;

if a broker system is available, automatically determining whether trading is enabled; and

performing a trading request for enabled trading.

The Examiner attempted to validate the rejection of claim 19 under 35 U.S.C. 102(a) by stating that the cited newswire "clearly teaches all of the positive limitations as set forth in claims 19-37;" whereas, the above highlighted limitations are in the alternative, and such conditional limitations are performed only if the user selects these functions. Firstly, it is not clear how the Examiner deemed the highlighted limitations to be in the alternative. After all, the claim language does not specify that the user can only select one of obtaining information and buy and sell securities. Secondly, it appears that the Examiner may be implying that conditional limitations can be ignored during examination if the cited newswire does not teach a user selection of such conditional functions. Final Office Action of 8/12/02, page 4. For instance, the Examiner stated,

> "Both the claimed subject matter and the newswire article disclose that the ATM machine offers a user with a choice between obtaining information or trading, if the user only obtains information such as stock quotes, then of the conditional trading functions are going to be performed, even though the article does mention the features of trading and buying and selling stocks using an ATM machine." Id.

As admitted by the Examiner, the cited newswire actually teaches an ATM having a screen that

> "...offers a choice between information or trading. *If you choose to trade,* the next screen is a full-page of disclosure about stock market risks. *Those who just want to check stock prices* will pull up a picture of a typewriter keyboard. By touching the screen, they can type in the name of the company or its sticker symbol and get a real-time stock quote or the previous day's mutual fund closing price." (Emphasis added) Cited Newswire, last two paragraphs.

Thus, the cited newswire does teach that the user can select a trade function or an information-check function and further teaches the features for the selected function. However, as stated earlier, those features taught by the cited newswire do not expressly or inherently describe each and every claimed limitation as set forth in independent claim 19. For instance, if the user selects the trade function, the cited newswire merely states that "the next screen is a full-page of disclosure about stock market risks." In other words, the cited newswire does not teach *automatically determining whether the user has established a link brokerage account* and other subsequent limitations in claim 19. Likewise, if the user selects the information-check function, the cited newswire merely states that a picture of a typewriter keyboard will be pulled up on the screen, and the user "can type in the name of the company or its ticker symbol and get a real-time stock quote..." In other words, the cited newswire does not teach automatically prompting the user *to select one information type from an information type group of holdings, stock quotes, symbol directory, and activity and orders* as stated in claim 19.

Regarding claims 20-37, the Examiner also rejected these claims under 35 U.S.C. 102(a) as being anticipated by the cited newswire. Yet, the Examiner did not specify teachings in the cited newswire that purportedly anticipate the various limitations recited in claims 20-37. Indeed, a review of the cited newswire shows that the claimed limitations of claims 20-37 are neither taught nor made obvious in the cited newswire.
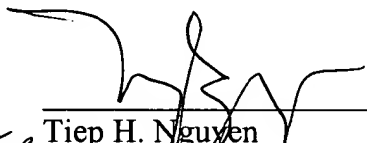
Accordingly, claims 19-37 cannot be *anticipated* by the cited newswire when all claimed limitations are not found in the cited newswire. Therefore, it is respectfully submitted that claims 19-37 are allowable over the cited newswire and all references of record.

Conclusion

For at least the reasons given above, the rejection of claims 1-21 is improper. It is respectfully requested that such rejections by the Examiner be reversed and claims 1-21 be allowed. Attached below for the Board's convenience is an Appendix of claims 1-21 as currently pending.

Respectfully submitted,

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(9)   Appendix

19. A method for a user at an automatic teller machine to obtain securities information and transactions, comprising:

the user accessing the automatic teller machine;

the automatic teller machine prompting the user with an option to perform securities functions;

the user selecting the option to perform securities functions;

automatically prompting the user to select a securities function from a securities function group of obtain information, buy securities, and sell securities;

the user selecting a securities function from the securities function group;

if the user selects the securities function of obtain information, automatically prompting the user to select one information type from an information type group of holdings, stock quotes, symbol directory, and activity and orders;

the user selecting an information type from the information type group;

providing to the user information for the selected information types;

if the user selects one securities function from the securities function group of buy securities and sell securities, automatically determining whether the user has established a linked brokerage account;

if the user has established a linked brokerage account, automatically determining whether the user has multiple brokerage accounts;

if the user does not have multiple brokerage accounts, automatically presenting the user with a portfolio profile message;

automatically determining whether a broker system is available;

if a broker system is available, automatically determining whether trading is enabled; and

performing a trading request for enabled trading.

20. The method of claim 19, further comprising the steps of:

automatically prompting the user as to whether the user has previously accessed securities functions;

indicating whether the user has previously accessed securities functions; and

if the user has not previously accessed securities functions, automatically providing to the user securities disclosure information.

21. The method of claim 19 wherein the step of providing to the user information for the selected information type further includes the steps of:

if the user selects one from the information type group of holdings, stock quotes, and symbol directory, automatically determining whether the user has established a linked brokerage account;

if the user has established a linked brokerage account, automatically determining whether the user has multiple brokerage accounts;

if the user does not have multiple brokerage accounts, automatically presenting the user with a portfolio profile message;

automatically determining whether a broker system is available; and

automatically proceeding with obtaining information from an available broker system for the selected information type.

22. The method of claim 19 wherein the step of providing to the user information for the selected information type further includes the steps of:

if the user selects the information type option of activities and orders, automatically prompting the user to select one activities and orders selection from the activities and orders group of open orders, trades awaiting settlement, and recent activity;

the user selecting an activities and orders selection;

automatically determining whether the user has established a linked brokerage account;

if the user has established a linked brokerage account, automatically determining whether the user has multiple brokerage accounts;

if the user does not have multiple brokerage accounts, automatically presenting the user with a portfolio profile message;

automatically determining whether a broker system is available;

automatically proceeding with obtaining information from an available broker system on the activities and orders selection.

23. The method of claim 22 wherein step of automatically proceeding with obtaining information from an available broker system on the activities and orders selection further includes the steps of:

if the activities and orders selection is open orders, automatically determining whether any orders are open;

if orders are open, automatically presenting the user with information on the open orders; and

if no orders are open, automatically informing the user that no orders are open.

24. The method of claim 22 wherein step of automatically proceeding with obtaining information from an available broker system on the activities and orders selection further includes the steps of:

if the activities and orders selection is trades awaiting settlement, automatically determining whether any trades are awaiting settlement;

if any trades are awaiting settlement, automatically presenting the user with information on the trades awaiting settlement; and

if no trades are awaiting settlement, automatically informing the user that no trades are awaiting settlement.

25. The method of claim 22 wherein step of automatically proceeding with obtaining information from an available broker system on the activities and orders selection further includes the steps of:

if the activities and orders selection is recent activity, automatically determining whether there is any recent activity;

if there is any recent activity, automatically presenting the user with the recent activity; and

if there is no recent activity, automatically informing the user that there is no recent activity.

26. The method of claim 19 further comprising the step of:

if the user has not established a linked brokerage account, automatically prompting the user to select a securities function from the securities function group of obtain information, buy securities, and sell securities.

27. The method of claim 19 further comprising the steps of:

if the user has multiple brokerage accounts, automatically applying an account resolver; and

automatically presenting the user with a portfolio profile message for the selected account.

28. The method of claim 19 further comprising the step of:

if a broker system is not available, automatically informing the user that trading is not available.

29. The method of claim 19 further comprising the step of:

if trading is not enabled, automatically informing the user that trading is not available.

30. The method of claim 19 wherein, if the user selects the securities function of buy securities, the step of performing the trading request further includes the steps of:

automatically prompting the user to select a security;

selecting a security;

automatically prompting a user as to whether to display the quote for the selected security;

indicating whether to display the quote for the selected security;

automatically determining whether trading is suspended;

automatically determining whether the selected security is tradable on the automatic teller machine; and

automatically proceeding with the buy request for tradeable securities.

31. The method of claim 30 wherein the step of automatically proceeding with the buy request for tradeable securities further includes the steps of:

automatically prompting the user to select a number of shares to buy;

selecting a number of shares to buy;

automatically prompting the user to select one from the purchase method group of limit price and market price;

the user selecting a purchase method;

if the user selects the purchase method of limit price, automatically determining whether the limit price is at least the minimum required price;

automatically determining whether the fluctuation of the security is at least the minimum fluctuation;

automatically determining whether a minimum percentage of funds are available for purchase of securities;

automatically prompting the user to determine whether the purchase price is acceptable;

indicating whether the purchase price is acceptable; and

if the purchase price is acceptable, automatically completing the buy request.

32. The method of claim 31 wherein the step of automatically completing the buy request further includes the steps of:

automatically prompting the user to specify the parameters of the purchase method selected;

specifying the parameters of the purchase method selected;

automatically prompting the user to select a purchase service option;

selecting a purchase service option;

automatically recapping the buy request;

automatically confirming the buy request; and

automatically placing the order.

33. The method of claim 19 wherein, if the user selects the securities function of sell securities, the step of performing the trading request further includes the steps of:

automatically presenting the user with a salable portfolio;

automatically determining whether a salable security is available;

automatically prompting the user to select a security;

selecting a security;

automatically prompting a user as to whether to display the quote for the selected security;

indicating whether to display the quote for the selected security;

automatically presenting the user with a possible duplicate summary;

automatically prompting the user to select a number of shares of salable securities to sell;

selecting a number of salable securities to sell; and

automatically proceeding with the sell request.

34. The method of claim 33 wherein the step of automatically proceeding with the sell request further includes the steps of:

automatically determining whether the price of the selected security is at least the minimum required price;

automatically determining whether at least the minimum number of shares selected for sale are selected;

automatically determining whether at least the number of shares selected for sale are held by the user;

automatically prompting the user to select one from the purchase method group of limit price and market price;

the user selecting a purchase method;

if the user selects the purchase method of limit price, automatically determining whether the limit price is at least the minimum required price;

automatically determining whether the fluctuation of the security is at least the minimum fluctuation;

automatically prompting the user to determine whether the sell price is acceptable;

indicating whether the sell price is acceptable; and

if the sell price is acceptable, automatically completing the sell request.

35. The method of claim 34 wherein the step of automatically completing the sell request further includes the steps of:

automatically prompting the user to select a sell service option;

selecting a service option;

automatically recapping the sell request;

automatically confirming the sell request; and

automatically placing the order.

36. The method of claim 19 wherein the automatic teller machine is a customer activated terminal.

37. The method of claim 30 wherein the step of automatically prompting the user to select a security includes the steps of:

automatically prompting the user to provide a symbol;

the user providing a symbol; and

automatically confirming that the provided symbol is acceptable.